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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,212	08/16/2001	Ryuji Hotta	212905US3	9211

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EXAMINER

A, PHI DIEU TRAN

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,212

Applicant(s)

HOTTA, RYUJI

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-8,11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-8,13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. PRODUCT BY PROCESS CLAIM:

“ The subject matter present is regarded as a product by process claim in which a product is introduced by the method in which it is made. It is the general practice of this office to examine the final product described regardless of the method provided by the applicant.”

The limitations “wherein the fastening member is enabled to be fixed ...by a nail or a screw....with the nail” in claims 1, 7, 8, 14 are treated according to the above office policy with regard to product by process limitations.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 6-8, 11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant figures 17-21 in view of Gabriel (2249125), Japan (293890) and Helfrecht (DE 3304806).

Applicant figures 17-21 shows a fastening member being disposed over an upper rabbeted horizontal edge of a lower siding board (2) and a lower rabbeted horizontal edge of an upper siding board (2), the fastening member is enabled to fixed to the framework by a nail or screw (through the holes 98, 99), the fastening member being of a shape that is elongated in lateral directions such that a plurality of studs of the framework that are disposed in a laterally aligned manner may be connected and fixed, the fastening member having a base plate portion abutting against rear side surfaces of siding boards (2) that are vertically disposed, a support portion (92) that is provided to erect frontward from the base plate portion, an upper board

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engaging portion that is bent in an oblique upward direction from the support portion an upper board engaging portion (93), an upper abutting portion (figure 17, the flat part to the top of part 911), a lower board engaging portion (94) that is bent in an oblique downward direction from the support portion, the base plate portion having an upper abutting portion and a lower abutting portion at its upper and lower portion, a lower rising portion (912) that is respectively formed in a frontward rising manner from the lower abutting portion, the lower rising portion comprising a horizontal plane portion (912) that is arranged to form a **substantially** right angle with respect to the central plate portion(91), a central plate portion being installed to connect the upper rising portion and the lower rising portion and abutting against the rear side surfaces of the siding boards, the support portion (92) is formed to be erected from the central plate portion, the upper rising portion comprising a sloped portion (911) wherein a nail hole is formed on the sloped portion, the siding boards attachment structure is a constructing structure employing a framework wall construction method (inherently so).

Applicant figures 17-21 does not show a lower abutting portion that abut the underlayment at its lower portion, an upper rising portion comprising a horizontal plane portion that is arranged to form a substantially right angle with respect to the central plate portion and forming in a frontward rising manner from the upper abutting portion, the lower abutting portion comprising a screw hole, the screw and nail holes being at substantially equal distance from the support portion, the screw hole is formed on one side of the support portion and the nail hole is formed on the opposite side of the support portion from the screw hole.

Gabriel shows underlayment (13) being interposed between a nail or screw and underframe (11).

Japan (figure 1) shows the lower abutting portion (6) having a screw hole (11) being at substantially equal distance from the support portion to that of the nail hole (12), the screw hole is formed on one side of the support portion and the nail hole is formed on the opposite side of the support portion from the screw hole

Helfrecht shows upper and lower rising portion comprising a horizontal plane portion (32) that is arranged to form a substantially right angle with respect to the central plate portion (34), a lower abutting portion (12) from which the lower rising portion extends frontwardly.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Applicant's figures 17-21 to show a lower abutting portion that abut the underlayment at its lower portion as taught by Helfrecht, an upper rising portion comprising a horizontal plane portion that is arranged to form a substantially right angle with respect to the central plate portion and forming in a frontward rising manner from the upper abutting portion as taught by Helfrecht, the lower abutting portion comprising a screw hole, the screw and nail holes being at substantially equal distance from the support portion, the screw hole is formed on one side of the support portion and the nail hole is formed on the opposite side of the support portion from the screw hole as taught by Japan ('890), abutting portions abut the underlayment as taught by Gabriel because having underlayment at the upper and lower portion would provide insulation to the frame structure as taught by Grabriel, having a lower abutting portion that abuts the underlayment at its lower portion, an upper rising portion comprising a horizontal plane portion that is arranged to form a substantially right angle with respect to the central plate portion and forming in a frontward rising manner from the upper abutting portion would enhance the supporting strength of the fastener as taught by Helfrecht, having a horizontal plane portion

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perpendicular to the central plate portion for the upper rising portion would enhance the supporting strength of the upper rising portion as taught by Helfrecht, and the lower abutting portion comprising a screw hole, the screw and nail holes being at substantially equal distance from the support portion, the screw hole is formed on one side of the support portion and the nail hole is formed on the opposite side of the support portion from the screw hole as taught by Japan ('890) would enable secure and balance attachment of the fastener to the building frame.

Per claims 4, 11, Applicant figures 17-21 as modified shows all the claimed limitations except for protruding portions projecting frontward from an upper end of the abutting portion and from a lower end of the lower abutting portion.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Applicant's figures 17-21's modified structure to show protruding portions projecting frontward from an upper end of the abutting portion and from a lower end of the lower abutting portion because it would strength the upper and lower abutting portion against bending moments and stress.

Per claims 6, 13, Applicant figures 17-21 as modified shows the lower abutting portion having an abutting surface that is substantially parallel to the central plate portion.

Response to Arguments

1. Applicant's arguments filed 11/10/04 have been fully considered but they are not persuasive.

Applicant states that Katsuyuki does not teach a bracket having a screw hole and a nail hole on opposite sides of the support portion, examiner respectfully disagrees. The reference

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shows a support portion (3) and a nail hole (12 or 11) on one side of the support portion, a screw hole (12 or 11) on the opposite side of the support portion. The holes being at equal distant from the support portion to enable secure and balance fastening of the structure to an underframe.

Applicant's limitation to the nail hole being disposed at an angle is shown in the application prior art of figures 17-21. The reference Katsuyuki is relied upon to show holes equal distance from a support portion. The modification thus shows a nail and a screw hole equidistant from the support portion, with the nail hole being on a slope portion as claimed. The argument is thus moot.

With respect to applicant's argument to "screw hole" vs. "nail hole", as pointed out during the interview, there is insufficient structure in the holes as claimed to distinguish the holes "nail or screw" from one another. The argument is thus moot.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is suggested in the prior art. The references each teach the advantage achieved by using the features disclosed. The combination of disclosed features thereof results in an improved structure. The argument is thus moot.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136, or 571-272-6864 only after April 07, 2005. The examiner can normally be reached on Monday-Tuesday, Thursday and Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phi Dieu Tran A

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1/24/05

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